

## REMARKS

This reply is being filed in response to the notice of non-compliant amendment dated June 10, 2009 indicating that the claim amendments made in the reply filed March 11, 2009 did not reflect amendments that were previously filed and entered for this application. The claim amendments made in the March 11, 2009 reply have accordingly been revised in this reply to reflect the amendments that were filed May 23, 2008. The remainder of this reply, with the exception of the following paragraph, is identical to the reply filed March 11, 2009.

Following entry of the foregoing amendments, claims 165, 167 to 183, and 202 to 258 will be pending in this patent application. Claims 165, 202, 219, 236, and 247 have been amended herein to more clearly define the claimed subject matter and to recite the length of the oligomeric compounds. Support for the amendments is found throughout the specification as originally filed, and the amendments and new claims thus do not introduce new matter into the application.

Applicant respectfully requests reconsideration of the rejections of record in view of the foregoing amendments and the following remarks.

### Alleged Double Patenting

Claims 165, 167 to 183, and 202 to 258 have been rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 1 and 2 of U.S. patent number 6,107,094. Claims 165, 167 to 173, 175, 179, 180, and 236 to 246 have been rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 43 to 47 of U.S. patent number 5,898,031. Finally, claims 165, 167 to 173, 175, 179, 180, and 236 to 246 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 43, 44, 94 to 104, and 135 to 145 of copending U.S. patent application number 10/281,349.

Without acquiescing that there has been an adequate showing that those of ordinary skill in the art would have found the rejected claims to have been obvious in view of the claims of the referenced patents and patent application, applicant nonetheless submits herewith the requested terminal disclaimers. This is being done solely in an attempt to advance prosecution of the present patent application, and should not be construed to constitute an acknowledgment of obviousness or any other substantive relationship among

the involved patent claims.

### Rejections Under 35 U.S.C. § 103

Claims 165, 167, 173, 175, 179, 180, and 236 to 246 have been rejected under 35 U.S.C. § 103(a) as allegedly rendered obvious by published PCT application number WO 94/02498 (“the Metelev application”). Applicant respectfully requests reconsideration and withdrawal of this rejection because the Metelev application fails to describe or suggest every limitation of the claims as amended herein. For example, the present claims recite methods for activating a double-stranded RNA nuclease that comprise contacting the nuclease with a double-stranded oligomeric compound comprising first and second oligonucleotides that are each independently 15 to 25 nucleoside subunits in length. The Metelev application fails to describe or suggest such oligonucleotide duplexes in which each oligonucleotide is 15 to 25 nucleosides in length, but instead describes oligonucleotides that are said to hybridize to mRNA. The Metelev application thus fails to describe or suggest the oligomeric compounds utilized in the presently claimed methods. Moreover, those of ordinary skill in the art would have had no reason to develop the claimed methods of activating double-stranded RNA nucleases utilizing the particular substrates recited in the claims before applicant’s invention in view of the description provided in the Metelev application. The claimed methods thus would not have been obvious at the time of the invention in view of the Metelev application.

The Office asserts, however, that “the context of the instant claims and the instant specification does not prohibit or make unreasonable an interpretation where one of the oligonucleotides is an mRNA.”<sup>1</sup> As discussed above, the claims have been amended herein to recite oligonucleotide duplexes in which each oligonucleotide is 15 and 25 nucleoside subunits in length. Since the Metelev application fails to describe or suggest such duplexes, the Metelev application fails to render obvious the claimed methods for activating a double-stranded RNA nucleases that utilize the duplexes as substrates. Applicant accordingly, respectfully, requests withdrawal of the rejection.

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<sup>1</sup> Office action dated September 8, 2008, page 8.

**Conclusion**

Applicant believes that the foregoing constitutes a complete and full response to the official action of record. Accordingly, an early and favorable action is respectfully requested.

Respectfully submitted,

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